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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,805	09/29/2000	Joseph R. Stonoha	632.0001USU	2958

7590 11/30/2004

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PLW

Office Action Summary	Application No.	Applicant(s)	
	09/676,805	STONOHA ET AL.	
	Examiner	Art Unit	
	Edward R. Cosimano	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 August 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-72 is/are pending in the application.
 4a) Of the above claim(s) none is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-72 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 10/16/03, 3/19/04 & 8/30/04 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____.
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____. 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) is acknowledged.
3. The proposed drawing corrections filed 16 October 2003 and 19 March 2004 and 30 August 2004 have been approved by the examiner.
 - 3.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) the specification, as originally filed, does not provide support for the invention as now claimed.

5.1.1 In regard to claims 1-9 as amended 30 August 2000, as disclosed in the specification in either:

A) the paragraph located between page 9, line 28, and page 10, line 12, "Referring to FIG. 7, a display screen 120 is presented if the labels are to be created. Display screen 120 includes display screen 90 and a lower portion 122. Lower portion 122 permits entry of the alphanumeric content of the labels of the job, one label at a time. To this end, a label attributes section 126 permits entry of the label content at 128 and changes in the positional palette at 134 or in the character palette at 136 that were previously selected via display screen 90. That is, the positional and character palettes selected via display screen 90 are used for all labels to be created, unless the user makes changes at 134 or 136. The alphanumeric content is entered via a character position 130 and a character ID or content 132, one character position at a time. An area 128 displays the entered content of the label. As each label is completed, actuation of an add button 138 lists it in a display area 124. When the ad hoc job is finished, an OK button 140 is actuated."; or

B) the paragraph located between page 10, line 13, and page 11, line 12, "Referring to FIG. 9, a display screen 181 for the formation of a positional palette is shown. Display screen 181 includes a positional palette name area 183 for entry of the positional palette name. An attribute area 198 includes a plurality of entry areas to define the attributes of the positional palette. Attribute area 198 includes a position area

197 for identifying the current character position for which attributes are being defined. For the current character position, the foreground color is entered in a foreground color area 187 and the background color is entered in a background area 189. A font attributes area 199 includes a font name area 191 for entry of a desired font name, a font size area 193 for entry of a font size and a font style area 195 for entry of a font style, such as normal, bold, italics, underscore, and the like. A shape attributes area 201 includes a type area 203, a size area 205 and a color area 207. Shape attributes area 201 permits entry of a geometrical shape in a character position. The shape, for example, may be a circle, a triangle, a rectangle, a square or any other shape. This shape is entered in type area 203. Size area 205 is for entry of the size of the shape, for example as a percentage of the character position area. Color area 207 is for entry of the color of the shape. To identify the character positions that the entered attributes are to apply, a check is entered in the box adjacent its number in a display area 185. If there is no check mark for a position, that position can be defined by a character palette. When the positional palette has been defined, an OK button 196 is actuated."; the user defines each individual label character by character by designating each individual character and it's attributes as the each character will appear on each individual label by designating each individual character followed by the next individual character. Hence, while the specification as originally filed supports designating a sequence of individual characters, the specification as originally filed does not support the label including "at least one character group disposed in a plurality of character positions", since a group of characters are never designated.

5.1.2 In regard to finding support within the disclosure for the claimed invention, applicant is reminded that "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

5.1.3 Claims 1-48 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claims 1-72 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claims 1-72, although one of ordinary skill at the time of the invention would have known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 1, why the “at least one of said plurality of labels of said single job is unrelated in numerical sequence to any of the other labels of said plurality of labels”, since the defining of step (a) does not include designating a number for any of the labels to be defined. See also claims 10 & 19.

B) in regard to claim 1, why and how many times is step (a) repeated when defining the labels, since neither the defining step (a) nor the repeating step (b) have an indication of when to stop the defining of labels. See also claims 10 & 19.

C) in regard to printing step (c) of claim 1, when is this step to be performed, since neither the defining step (a) nor the repeating step (b) have an indication of when to stop the defining of labels. See also claims 10 & 19.

D) in regard to claims 2-4 why is there an additional step (d) of assigning a positional palette in claims 2-4, since as disclosed in the specification at:

(1) the paragraph located between page 9, line 28, and page 10, line 12, “Referring to FIG. 7, a display screen 120 ... the ad hoc job is finished, an OK button 140 is actuated.”; or

(2) the paragraph located between page 10, line 13, and page 11, line 12, "Referring to FIG. 9, a display screen 181 ... has been defined, an OK button 196 is actuated.";

since as disclosed these features are part of defining of step (a) of claim 1 includes the designation/assignment of a positional palette. See also claims 11-13 & 20-22.

E) in regard to claim 5;

(1) how this step would fit into claim 1; and

(2) when or under what circumstances or conditions would the label have a barcode,

since as disclosed these actions/functions are part of defining of step (a) of claim 1 includes the designation/assignment of the content of a character position. See also claims 14 & 23.

F) in regard to suppression of claims 6-7;

(1) why would the printing of a barcode/character need to be suppressed, since claim 1 does not recite a barcode but does recite the designation of a character; and

(2) when or under what circumstances or conditions would the printing of a barcode/character be suppressed;

since as disclosed these actions/functions are part of defining of step (a) of claim 1 includes the designation/assignment of the content of a character position. See also claims 15-16 & 24-25.

G) in regard to claim 8;

(1) how this step would fit into claim 1;

(2) why would the barcode need to be rotated, since claim 1 does not recite a barcode but does recite the designation of a character; and

(3) when or under what circumstances or conditions would the barcode be rotated;

since as disclosed these actions/functions are part of defining of step (a) of claim 1 includes the designation/assignment of the content of a character position. See also claims 17 & 26.

H) in regard to claim 9, how this step would fit into claim 1, since it is unclear in claim 1 when if ever the labels would be printed. See also claims 18 & 27.

I) in regard to claim 28, how the assigning of step (b) is related to the assignment of a positional palette in step (a) since the assigning of step (b) does not include using the assigned positional palette of step (a). See also claims 39 & 50.

J) in regard to printing step (c) of claim 28, when is this step to be performed, since neither the assigning of step (a) nor the assigning of step (b) have an indication of when to stop the assigning positional palettes and characters. See also claims 39 & 50.

K) in regard to claims 29-31 why is there an duplication of assigning a positional palette in these claims 2-4, since this function/action was already performed in step (a). See also claims 40-42 & 51-53.

L) in regard to printing step (d) of claims 34-36, 45-47 & 56-58, when is this step to be performed, since:

- (1) neither the assigning of step (a) nor the assigning of step (b) have an indication of when to stop the assigning positional palettes and characters;
- (b) a starting location has not been designated in these claims.

M) in regard to claim 37, how this step would fit into claim 28, since it is unclear in claim 28 when if ever the labels would be printed. See also claims 48 & 59

N) in regard to claim 38, why a numerical sequence is assigned to the label, since this numeric value is never used by the claimed invention. See also claims 49 & 60.

O) in regard to claims 61, 64 & 67 and either:

- (1) step (a) or the first means and how the current count of the stock of labels may be determined since the beginning number of labels has not been determined; or

(2) step (b) or the third means and how the user may be warned, since the actual current count of labels is not compared to the warning count; or

(3) steps (a) and (c) or the first and fourth means and how the current count of the stock of labels may be determined since the beginning number of labels has not been determined; or

(4) step (d) or the fifth means and the adjusting, since the number of labels that have been used is never determined.

P) in regard to claims 62, 65 & 68 and how, why and under what circumstances the warning count may be adjusted, since this warning count value is never used in the claims.

Q) in regard to claim 63, 66 & 69 and how, why and under what circumstances the order may be placed, since this a need for more labels has not been determined in the claims.

R) in regard to claims 70-72 how either an “ad hoc interface”, a “serial job interface” or an “interface” that used to enter data to define labels and a serial job may be used as a “method of forming labels, since at least the entered data is not used to generate labels.

6.2 In regard to claims 33, 44, since claim 28/29, 39/40/43 lacks a “second positional palette” it is unclear how the first and second positional palettes can be different.

6.3 In regard to claims 42 & 49, since claim 42 deals with a character attribute and claim 49 deals with a numerical sequence of labels, it is unclear how the subject matter of claims 42 & 49 would find antecedent support in claim 46.

6.4 In regard to claim 71, this claim is vague, confusing and unclear since the subject matter of claim 72 is unrelated to the subject matter of claim 71 from which it depends.

6.5 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7.1 Claims 61-72 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 The instant claims recite a system, (claims 64-66), and a method comprising a series of steps to be performed on a computer, (claims 61-63 & 70-71), and a manufacture comprising program code to be executed by a computer, (claims 67-69), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

7.1.2 In regard to claims 61-72, the invention as set forth in these claims merely describes:

- A) in regard to claims 61-69 a system, method and article which is directed to tracking the stock of inventory and giving a warning with a determination of the original number of labels or when a warning should be given;
- B) claims 70 & 72 an interface to enter data that is not used; and
- C) claim 71 and serial job interface that is never used.

However, the process/system/manufacture as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application within the technological or useful arts.

7.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

7.1.4 It is further noted in regard to claims 61-72, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Hence, the invention of claims 61-72 is merely directed to an hypothetical mental exercise that manipulates an abstract ideas of tracking inventory and entering data with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

7.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function

descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

7.1.6 In practical terms, claims define nonstatutory processes if they:

- A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or
- B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

7.1.7 In view of the above analysis claims 61-72, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

7.2 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

- a) obtaining the dimensions of said obstruction which affect the parameters of flow;
- b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;
- c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter
- d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

7.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

7.2.3 As can be seen from claims 1-72, these claims are directed to a series of devices or steps/actions/functions, which as set forth above in regard to the rejection of claims 1-72 under 35 U.S.C. § 112 2nd paragraph, the recited limitations are not clearly and definitely interconnected to one another and therefore do not provide a useful system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

7.3 Claims 61-72 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that claims 1-72 lack utility for the reason set forth above in sections 6.1 through 7.2.3.

In view of the above, it is considered that the invention of claims 1-72 lack substantial and practical utility.

7.4 Claims 1-72 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1-48, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 112 1st paragraph as set forth above.

B) in regard to claims 1-72, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

C) in regard to claims 1-7, 9-16, 18-25, 27-37, 39-48, 50-59 & 61-72, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 102 as set forth below.

D) in regard to claims 8, 17, 26, 38, 49 & 60, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 103 as set forth below.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8.1 Claims 61-69 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Kagami et al (5,128,861) or LoBiondo et al (5,305,199) or Yamashita et al (5,594,529).

8.1.1 In regard to claims 61-69, either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529) disclose a computer implemented system and method of managing/monitoring the stock or amount of a supply of a consumable resource. Under the control of properly programmed operating system as stored in the memory the computer systems of either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529) the actual/current amount/count of the available supply of the consumable resource, for example, the supply of printable media/labels/paper in a reproduction machine, is monitored relative to one or more predetermined warning levels for the actual/current amount of the supply of the consumable resource as set by the operator/user. Further, in the systems of either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529) maintain the actual/current amount/count of the supply of the available consumable resource by adjusting the actual/current amount/count of available supply of the consumable resource based on either:

- A) the actual/current amount of the consumable resource that has been used;
and/or
- B) the actual/current amount of the consumable resource that has been restocked.

Where in the systems of either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529), if the actual/current amount/count of the supply of the available consumable resource falls below any one of the one or more predetermined warning levels for the consumable resource, then the operator/user is provided with a suitable type of alert/warning/indication of this fact by the systems of either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529). Based on the alert/warning/indication provided to the operator/user of the systems

of either Kagami et al ('861) or LoBiondo et al ('199) or Yamashita et al ('529), the actual/current amount/count of the supply of the available consumable resource is restocked and/or reordered.

8.2 Claims 1-7, 9-16, 18-25, 27-37, 39-48, 50-59 & 70-72 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Mellgren, III et al (6,085,126).

8.2.1 in regard to claims 1-7, 9-16, 18-25, 27-37, 39-48, 50-59 & 70-72, Mellgren, III et al ('126) disclose a computer implemented system and method of designing printable media. Under the control of properly programmed operating system as stored in the memory the computer system of Mellgren, III et al ('126) the user is permitted to use a suitable user interface to define:

- A) the size and shape of the printable media;
- B) the location of any graphic content of the design to be placed on the printable media; and
- C) the position and attributes, for example, the size, the appearance, the font, the color, etc. of the alphanumeric content of the printable media;

until the user has finished designing the printable media is complete since the user has designated what is to be printed and what is not to be printed. After the user has completed the design the finished design is displayed to the user on the display of the computer system of Mellgren, III et al ('126) and if the design is approved the finished printable media is printed as instructed by the user. The above process may be repeated for each of the printable media being designed by the user.

8.2.2 In regard to the claimed palette, it is noted that applicant has failed to define the exact nature of the "palette", hence this word is given its common ordinary meaning. In view of this one of ordinary skill would know that it is common practice to set forth to the user various options by presenting to the user a palette or a display showing a number of possible positions/colors/fonts available to the user. The user then would select the desired item from one of the available palettes. Note for example a color palette or a graphics palette or a font palette or a palette of label designs.

8.2.3 In regard to the use of a single print job, it is noted since the instant claims fail to recite a specific number of labels, any instruction to print one or more labels would in fact be recognized as a single print job as understood by one of ordinary skill.

8.2.4 In regard to the interface of claims 70-72, it is noted that the user of the system of Mellgren, III et al ('126) would require an user interface in order to operate the system of Mellgren, III et al ('126).

8.3 In regard to the claimed "labels", since the nature or type of the monitored item does not affect the operation of the system, the claimed designation of "labels" is deemed to be non-functional descriptive material that is directed to an intended field of use. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time

the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9.1 Claims 8, 17 & 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mellgren, III et al (6,085,126) as applied above to claims 1-7, 9-16, 18-25, 27-37, 39-48, 50-59 & 70-72 and further in view of an obvious variations.

9.1.1 It is noted in regard to claims 8, 17 & 26, that Mellgren, III et al ('126) does not permit the user to designate a rotational orientation for the barcode, however, Mellgren, III et al ('126) does permit the user to define the exact location on the barcode on the label relative to the other information on the label. Since the teachings of Mellgren, III et al ('126) clearly permit the user of Mellgren, III et al ('126) to designate, that is define, the position and orientation of a barcode which to appear on the label, where such a designation would inherently include a rotational orientation of 0 degrees or could be rotated at any angle from the position and orientation of the remaining information by not excluding this possibility, it would have been obvious to one of ordinary skill at the time the invention was made that the system of Mellgren, III et al ('126) does permit the user to define a rotational orientation for the barcode and/or text that is to appear on the label.

9.2 Claims 38, 49 & 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mellgren, III et al (6,085,126) as applied above to claims 1-37, 39-48, 50-59 & 70-72 and further in view of the Office Systems article as interpreted in view of Eckert (4,649,266).

9.2.1 In regard to claim 38, 49 & 60, and the sequential numbering of the labels, it is noted that the system of Mellgren, III et al ('126) does not keep track of the number of labels by sequentially numbering each label. However, in the environment of printing postage labels with postage indicia the Office Systems article teaches that a postage indicia label may include a personalized message as well as the require postage indicia data. Where as taught by Eckert ('266) a postage indicia contains an indication of the piece count or number of postage indicia that have been printed, where this number always increases when postage is printed. Since, Mellgren, III et al ('126) discloses a system and method of custom designing printable media, such as the postage indicia of the Office Systems article, it would have been obvious to one of ordinary skill at the time the postage invention was made that if the system of Mellgren, III et

al ('126) were used to customize postage indicia, then the printed media would include a sequential indication of the number of printed media produced by the system of Mellgren, III et al ('126) as taught by the Office Systems article as interpreted in view of Eckert ('266).

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the 35 U.S.C. § 102 rejection, since:

A) in regard to the nature of the "positional pallet" applicant references fig. 3 of the instant disclosure, since this fig. clearly depicts a label that includes a barcode and some numbers, it can not be seen how one of ordinary skill would recognize what is depicted as a positional pallet or as a pallet as a pallet would be understood by one of ordinary skill. Further, since Mellgren, III et al (6,085,126) permits the user to designate the location of text and numbers that are to appear on the label, one of ordinary skill would interpret this teaching as including a positional pallet as applicant has argued this phrase to mean.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

- 12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.
- 12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.
- 12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

11/28/04

Edward Cosimano
Edward R. Cosimano
Primary Examiner A.U. 3629